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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,301	01/25/2002	Mark Chasin	207.1300US	3895
23280	7590	04/15/2004	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			TRAVERS, RUSSELL S	
			ART UNIT	PAPER NUMBER

1617

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/057,301	CHASIN ET AL.	
	Examiner	Art Unit	
	Russell Travers, J.D., Ph.D	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 69-80, 82-86, 88 and 90-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-68, 81, 87 and 89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The Election filed January 22, 2004 has been received and entered into the file.

Claims 1-93 are presented for examination.

Applicant's election without traverse of Group 1, in Paper filed January 22, 2004 is acknowledged.

Claims 69-80, 82-86, 88 and 90-93 reading on non-elected subject matter are withdrawn from consideration.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-68, 81, 87 and 89 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S.

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Patent No. 6,248,345. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are obvious variants of those set forth in the referenced issued patent.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,

- 5) the state of the prior art,
- 6) the relative skill of those in the art
- 7) the predictability of the art, and
- 8) the breadth of the claims.

Applicant fails to set forth the criteria that defines those procedures useful for determining either the mean Cmax "measured by microdialysis in the tissue at the site" in-vivo, or the Tmax of bupivacaine "at the tissue site" in-vivo to practice the instant invention as herein envisioned. Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these medicament levels without undue experimentation. In the instant case, only a limited number of examples for those procedures useful for determining either the mean Cmax "measured by microdialysis in the tissue at the site", or the Tmax of bupivacaine "at the tissue site" to practice the instant invention as herein envisioned are set forth, thereby failing to provide sufficient working examples. It is noted that these examples are neither exhaustive, nor define the class of procedures required. The pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. The instant claims read on all situations and procedures employed for determining either the mean Cmax "measured by microdialysis in the tissue at the site" in-vivo, or the Tmax of bupivacaine "at the tissue site" in-vivo to practice the instant invention as herein envisioned, necessitating an exhaustive search for the embodiments suitable to practice the claimed invention. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation.

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Claims 33-68 and 81 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApl 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art
- 7) the predictability of the art, and
- 8) the breadth of the claims.

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Applicant fails to set forth the criteria that allows the skilled artisan to evaluate those therapeutic benefits herein envisioned by the instant "USP paddle method", or the "von Frey hair" absent undue experimentation. To practice the invention as envisioned, the skilled artisan must evaluate all formulations to insure their suitability for practicing the invention as claimed. Examiner notes no guidance is provided to the skilled artisan allowing the instant limitations to be ascertained absent experimentation in every situation. Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these medicament levels in-vivo, as dictated by the instant claims, without undue experimentation. In the instant case, only a limited number of those procedures useful for determining the effectiveness of the instant formulations are provided, thereby failing to provide sufficient working examples. It is noted that these examples are neither exhaustive, define the levels of medicaments envisioned, nor provide any predictive information to assess other envisioned limitations metes and bounds. The pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. The instant claims read on all situations and procedures employed for determining in-vivo effect for the claimed therapeutic regimens, necessitating an exhaustive search for the embodiments suitable to practice the claimed invention. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation.

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Claims 10-11, 15-18, 20-21, 24, 26-31 45-46 and 48-49 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 33-68 and 81 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 38-68 and 81 are rendered indefinite by the phrases defines "measured by microdialysis in the tissue at the site", or "at the tissue site" and thereby failing to clearly set forth the metes and bounds of the patent protection desired. Criteria defining those procedures useful for determining either the mean Cmax "measured by microdialysis in the tissue at the site" in-vivo, or the Tmax of bupivacaine "at the tissue site" in-vivo to practice the instant invention as herein envisioned are not set forth in the specification, thereby failing to provide information defining the instant inventions metes and bounds. Applicant's term fails to clearly define the subject matter encompassed by the instant claims, thus is properly rejected under 35 USC 112, second paragraph.

Claims 50-54 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 50-54 are rendered indefinite by the phrase "mean somesthetic response" and thereby failing to clearly set forth the metes and bounds of the patent protection

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desired. Examples of what a "mean somesthetic response" would be are not set forth in the specification. Absent such exemplification, the skilled artisan could not establish the identity of those situations which would provide a "mean somesthetic response" .

Applicant's phrase fails to clearly define the subject matter encompassed by the instant claims, thus is properly rejected under 35 USC 112, second paragraph.

Claims 1-32, 87 and 89 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals & Interferences in *Ex parte Wu*, 10 USPQ2d 2300 (BdApls 1989) at 2303, as to where broad language is followed by "such as" and then narrow language. The Board stated, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. In the present instance, claims 1 and 89 recite the broad recitations of 65:35DL copolymer of lactic and glycolic acid, and 60% to 85% bupivacaine free base, and the claims also recite, copolymer having a molecular weight

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of about 40,000 Daltons to 120,000 Daltons and "bupivacaine free base from about 45 mg to about 360 mg", which is a narrower statement of the range/limitation. Applicants recitation of the broad range or limitation together with a narrow range or limitation renders independent claims 1 and 89, and dependant claims 2-32 and 87 properly rejected as indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 33-68 are rejected under 35 U.S.C. § 102(a) as being anticipated by Berde et al (340), or (187).

Applicants' attention is directed to *Ex parte Novitski*, 26 USPQ2d 1389 (BOPA 1993) illustrating anticipation resulting from inherent use, absent a *haec verba* recitation for such utility. In the instant application, as in *Ex parte Novitski*, supra, the claims are directed to preventing a malady or disease with old and well known compounds or compositions. It is now well settled law that administering compounds inherently possessing a protective utility anticipates claims directed to such protective use. Arguments that such protective use is not set forth *haec verba* are not probative. Prior use for the same utility clearly anticipates such utility, absent limitations distancing the proffered claims from the inherent anticipated use. Attempts to distance claims from anticipated utilities with specification limitations will not be successful. At page 1391, *Ex*

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parte Novitski, supra, the Board said "We are mindful that, during the patent examination, pending claims must be interpreted as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). As often stated by the CCPA, "we will not read into claims in pending applications limitations from the specification." *In re Winkhaus*, 52 F.2d 637, 188 USPQ 219 (CCPA 1975)." In the instant application, Applicants' failure to distance the proffered claims from the analgesic utility and those levels inherently provided by the medicament administration taught by Brede et al, renders such claims anticipated by the prior inherent use. Although the instant claims recite various methods for assessing analgesia, the skilled artisan would have seen administration at the levels herein recited, in the pharmaceutical compositions herein claimed as providing identical analgesia regardless the evaluation criteria.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-68 81, 87 and 89 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldenheim et al (345) or (335).

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The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-68, 81, 87 and 89 are rejected under 35 U.S.C. 103(a) as being obvious over Goldenheim et al (345) or (335).

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is

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the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Goldenheim et al teach the claimed bupivacaine and dexamethasone as old and well known in combination with various pharmaceutical carriers and excipients in a lactic acid, glycolic acid polymer microsphere dosage form. This medicament is taught as useful for treating pain, viewed by the skilled artisan as indistinguishable from that use herein envisioned. Claims 1-68, 81 87 and 89, and the primary references, differ as to:

- 1) the recitation of analgesic thresholds desired, and
- 2) administration of the medicaments in various locations.

The instant claims are directed to analgesia with an old and well known analgesic compound. Arguments that Applicant's claims are not directed to the old and well known ultimate utility for this compound are not probative. It is well settled patent law that mode of action elucidation fails to impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.". Additionally, where the Patent Office has reason to believe that a

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functional limitation asserted to be critical for establishing novelty in the claimed subject matter, may in fact be an inherent characteristic of the prior art, it possesses the authority to requires the applicant to prove that the subject matter shown to be in the prior art dose not posses the characteristic relied on. In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various biochemical intermediates. The ultimate utility for the claimed compounds is old and well known, rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed

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invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-68, 81, 87 and 89 are rejected under 35 U.S.C. § 103 as being unpatentable over Brede et al (340) and (187).

Brede et al teach the claimed bupivacaine and dexamethasone as old and well known in combination with various pharmaceutical carriers and excipients in a lactic acid, glycolic acid polymer microsphere dosage form. This medicament is taught as useful for treating pain, viewed by the skilled artisan as indistinguishable from that use herein envisioned.

Bupivacaine and dexamethasone ((340) see columns 2 and 7) are taught as useful in prolonging analgesia ((340) see column 15, lines 17-20) when administered concomitantly in a high molecular weight lactic acid- glycolic acid polymer ((340) see column 2 and column 9, line 44). These therapeutic agents are taught as useful in the amounts and ratios herein claimed ((340) see columns 2, 7 and column 15, line 21-25).

Claims 1-68, 81 87 and 89, and the primary references, differ as to:

- 1) the recitation of analgesic thresholds desired, and
- 2) administration of the medicaments in various locations.

The instant claims are directed to analgesia with an old and well known analgesic compound. Arguments that Applicant's claims are not directed to the old and well known ultimate utility for this compound are not probative. It is well settled patent law that mode of action elucidation fails to impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at

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229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.". Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter, may in fact be an inherent characteristic of the prior art, it possesses the authority to requires the applicant to prove that the subject matter shown to be in the prior art dose not posses the characteristic relied on. In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various biochemical intermediates. The ultimate utility for the claimed compounds is old and well known, rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

Claims 12-14, 19, 22-24 and 26-31 specifically requires administration of injectable pharmaceutical compositions. Brede et al employed the claimed compound in dermal form and injectable form, not specifically reciting another formulation. The skilled artisan would have seen dermal and injectable compositions, and the administration of these compounds by conventional means as residing in the skilled artisan purview.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Travers, J.D.,Ph.D whose telephone number is

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571-272-0631. The examiner can normally be reached on Monday to Thursday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Russell Travers J.D., Ph.D.
Primary Examiner
Art Unit 1617